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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,307	04/06/2001	Tadahiro Ohmi	P 280043 EL00026CDC	4153

909 7590 08/13/2003

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17  
EXAMINER

ALEJANDRO MULERO, LUZ L

ART UNIT

PAPER NUMBER

1763

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/827,307

Applicant(s)

OHMI ET AL.

Examiner

Luz L. Alejandro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claim 7 is objected to because of the following informalities: the phrase "on which a substrate" is repeated in line 2. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Omi et al., JP 2000-040695A (see Figures and abstract).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claims 1 and 3-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Shan et al., U.S. Patent 6,232,236.

Shan et al. shows the invention as claimed including a plasma processing apparatus comprising: a first electrode 215 on which a substrate 164 subjected to a plasma process is placed; a magnetic field applying means 270 for applying a magnetic field to a surface of the substrate to which the plasma process is applied; an auxiliary electrode 220 provided on an outer periphery of said first electrode to excite plasma in the vicinity of the auxiliary electrode (see Fig. 2 and col. 3-line 30 to col. 5-line 10). The apparatus is capable of producing the plasma electron drift as claimed and is capable of applying a static magnetic field if so desired.

Regarding claim 3, note that the level of the substrate placed on the first electrode and the auxiliary electrode are substantially equal to each other (see Fig. 2).

Concerning claim 5, note that the first electrode and the auxiliary electrode can be powered by the same RF source 302 (see Fig. 3). Also, the apparatus of Shan et al. is capable of supplying rf power to the first electrode and to the auxiliary electrode having the same frequency but different phases.

With respect to claim 6, note that both electrodes can have their own individual RF power supplies with different frequencies (see Figs. 2 and col. 3-line 31 to col. 5-line 10). Also, the apparatus of Shan et al. is capable of supplying a higher frequency to the auxiliary electrode than to the first electrode.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shan et al., U.S. Patent 6,232,236 in view of Dornfest et al., U.S. Patent 5,949,409.

Shan et al. is applied as above but does not expressly disclose covering the auxiliary electrode with insulating material. Dornfest et al. discloses an apparatus in which an electrode is protected from the plasma atmosphere with an insulating material (see, for example, the abstract, col. 4-line 45 to col. 5-line 40, and fig. 16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Shan et al. as to cover the auxiliary electrode with an insulating material in order to protect it from the plasma atmosphere.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shan et al., U.S. Patent 6,232,236 in view of Ohmi et al., WO 98/39500.

Shan et al. is applied as above but does not expressly disclose a plasma processing method including applying a static magnetic field. Ohmi et al. discloses applying a static magnetic field for achieving uniform processing results while allowing for a miniaturized apparatus (see abstract and paragraph bridging pages 1 and 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Shan et al., as to as apply a static magnetic field in order to achieve uniform processing results while allowing for a miniaturized apparatus.

Claims 1, 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asamaki et al., U.S. Patent 4,950,956 in view of Okumura et al., U.S. Patent 6,297,165 B1.

Asamaki et al. shows the invention substantially as claimed including a plasma processing apparatus comprising a first electrode 22 on which a substrate 25 subjected to a plasma process is placed and magnetic field applying means 30 for applying a magnetic field to a surface of the substrate 25 to which the plasma process is applied (see Figs. 1-8 and col. 2-line 49 to col. 4-line 52).

Asamaki et al. lacks anticipation of an auxiliary electrode provided on an outer periphery of said first electrode to excite plasma by the auxiliary electrode so as to cause electrons in the plasma to drift from a front surface to a back surface of said

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auxiliary electrode and from the back surface to the front surface of said auxiliary electrode. Okumura et al. discloses an auxiliary electrode 11 provided on an outer periphery of a first electrode 7 on which a substrate 8 lies which excites plasma from a RF source 10 (see Fig. 3 and col. 4-line 43 to col. 5-line 38). In view of this disclosure, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Asamaki et al. so as to contain the auxiliary electrode structure of Okumura et al. because this allows for accurate measuring of the self-bias potential (see abstract). Furthermore, the incorporation of the auxiliary electrode feature of Okumura et al. into the Asamaki et al. reference would inherently produce an apparatus capable of producing the plasma electron drift as claimed.

Regarding claim 3, note from Figure 2 of Okumura et al. that the level of substrate 8 placed on the first electrode 7 and the auxiliary electrode are equal to each other.

With respect to claim 4, note that the magnet of Asamaki et al. is ring-shaped (see Fig. 2) and contains poles (see abstract).

Concerning claim 5, note that the first electrode 7 and auxiliary electrode 11 of Okumura et al. are both powered by the same RF source 10 and the auxiliary electrode 11 has a capacitor 23 connected therewith which will alter the phase (see Fig. 3).

Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asamaki et al., U.S. Patent 4,950,956 in view of Okumura et al., U.S. Patent 6,297,165

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B1 as applied to claims 1, 3-5 above, and further in view of Dornfest et al., U.S. Patent 5,949,409.

Asamaki et al. and Okumura et al. are applied as above but do not expressly disclose covering the auxiliary electrode with insulating material. Dornfest et al. discloses an apparatus in which an electrode is protected from the plasma atmosphere with an insulating material (see, for example, the abstract, col. 4-line 45 to col. 5-line 40, and fig. 16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Asamaki et al. modified by Okumura et al. as to cover the auxiliary electrode with an insulating material in order to protect it from the plasma atmosphere.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Asamaki et al., U.S. Patent 4,950,956 in view of Okumura et al., U.S. Patent 6,297,165 B1 as applied to claims 1, 3-5 above, and further in view of Shan et al., U.S. Patent 6,232,236 B1.

Asamaki et al. and Okumura et al. are applied as above but lack anticipation of applying a higher frequency to the auxiliary electrode than to the first electrode. Shan et al. discloses having an outer electrode 220 and an electrode 215 on which the substrate lies, where both electrodes have their own individual RF power supplies with different frequencies (see Figs. 2-3 and col. 3-line 31 to col. 5-line 10). In view of this disclosure, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Asamaki et al. modified by Okumura et al. so as to



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provide, for instance, a higher frequency to the auxiliary electrode than to the first electrode because this allows for better controllability of the plasma in the region of the substrate.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Asamaki et al., U.S. Patent 4,950,956 in view of Okumura et al., U.S. Patent 6,297,165 B1 as applied to claims 1, 3-5 above, and further in view of Ohmi et al., WO 98/39500.

Asamaki et al. and Okumura et al. are applied as above but do not expressly disclose a plasma processing method including applying a static magnetic field. Ohmi et al. discloses applying a static magnetic field for achieving uniform processing results while allowing for a miniaturized apparatus (see abstract and paragraph bridging pages 1 and 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Asamaki et al. modified by Okumura et al., as to as apply a static magnetic field in order to achieve uniform processing results while allowing for a miniaturized apparatus.

### ***Response to Arguments***

Applicant's arguments filed 05/30/ 03 have been fully considered but they are not persuasive. Concerning applicant's statement regarding the certified translation of the priority document being provided on October 4, 2001 or a copy being enclosed with the amendment filed on 05/30/03, there appears to be no such translation in the instant application. It is noted that a certified copy of the priority document itself was received

on February 4, 2002 but this certified copy did not contain a translation. For this reason, the rejection under 35 USC 102(a) using the Omi et al. reference, JP 2000-040695A is respectfully maintained.

Concerning the rejection under 35 USC 103 using the Asamaki et al. and Okumura et al. references, applicant argues that there is no suggestion or motivation in Okumura et al. that by applying an appropriate magnetic field, the electrons will drift as required by the claims. However, all of the elements required by applicant to produce such an electron drift including the auxiliary electrode and magnets will be present by the combination of the Asamaki et al. and Okumura et al. references. Furthermore, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Regarding the argument that Asamaki et al. fails to teach the presence of an auxiliary electrode, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

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not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With respect to the challenge of the official notice, note that Dornfest et al., U.S. Patent 5,949,409, has been relied upon in response to the challenge of the official notice.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luz L. Alejandro whose telephone number is 703-305-4545. The examiner can normally be reached on Monday to Thursday from 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Mills can be reached on 703-308-1633. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Luz L. Alejandro  
Primary Examiner  
Art Unit 1763

August 6, 2003